



1632

PTO/SB/21 (01-03)

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TRANSMITTAL FORM

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Total Number of Pages in This Submission

| | |
|------------------------|-------------------|
| Application Number | 09/900,715 |
| Filing Date | July 6, 2001 |
| First Named Inventor | KEITH D. ALLEN |
| Art Unit | 1632 |
| Examiner Name | Joseph T. Woitach |
| Attorney Docket Number | R-775 |

| ENCLOSURES (Check all that apply) | | |
|--|---|--|
| <input type="checkbox"/> Fee Transmittal Form | <input type="checkbox"/> Drawing(s) | <input type="checkbox"/> After Allowance Communication to Group |
| <input type="checkbox"/> Fee Attached | <input type="checkbox"/> Licensing-related Papers | <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences |
| <input checked="" type="checkbox"/> Amendment/Reply | <input type="checkbox"/> Petition | <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) |
| <input type="checkbox"/> After Final | <input type="checkbox"/> Petition to Convert to a Provisional Application | <input type="checkbox"/> Proprietary Information |
| <input type="checkbox"/> Affidavits/declaration(s) | <input type="checkbox"/> Power of Attorney, Revocation | <input type="checkbox"/> Status Letter |
| <input checked="" type="checkbox"/> Extension of Time Request | <input type="checkbox"/> Change of Correspondence Address | <input type="checkbox"/> Other Enclosure(s) (please identify below): |
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| <input type="checkbox"/> Response to Missing Parts/ Incomplete Application | | |
| <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | | |
| | Remarks | |

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

| | |
|--------------------|-------------------|
| Firm or Individual | Aaron T. Hokamura |
| Signature | |
| Date | February 3, 2003 |

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on this date: February 3, 2003

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| Typed or printed | Don Mixon |
| Signature | |
| Date | February 3, 2003 |

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Washington, DC 20231.

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#9
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2/24/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Keith D. ALLEN

Group Art Unit: 1632

Serial No.: 09/900,715

Examiner: Woitach, Joseph T.

Filed: July 6, 2001

Attorney Docket No.: R-775

For: TRANSGENIC MICE CONTAINING PROTEIN PHOSPHATASE 2C GENE
DISRUPTIONS

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action mailed October 03, 2002, concerning the Examiner's restriction to the claims, Applicants hereby provisionally elect, with traverse, the claims of Invention I (claims 1-12 and 17-23).

In the restriction, the Examiner asserts that claims 1-25 are drawn to three distinct subjects, grouped as: Invention I (claims 1-12 and 17-23), drawn to a targeting construct comprising a polynucleotide sequence homologous to the sequence encoding protein phosphatase 2C and a selectable marker and the transgenic animal generated with said construct, and method of producing said construct; Invention II (claims 13-15 and 24), drawn to a method of identifying an agent which modulates activity of protein phosphatase 2C in a cell comprising a disruption in a protein phosphatase 2C gene; and Invention III (claims 16 and 25), drawn to an agent which modulates the expression of protein phosphatase 2C.

Specifically, the Examiner asserts that the inventions are distinct, each from the other because Inventions I-III are drawn to different and separate products and methods which are materially different and capable of separate use. The Examiner further asserts that Inventions I-III would require separate searches and consideration. The Applicant respectfully disagrees with the Examiner's assertion in that the claims of Inventions I, II and III are related to one another and a separate search or examination would not unduly burden the Examiner.

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Although Applicants have provisionally elected Group I for purposes of advancing prosecution of the present application, Applicants contend, for the foregoing reasons, that the restriction requirement is improper. Accordingly, Applicants respectfully request reconsideration and withdrawal of the requirement.

A Petition for the Extension of Time for response to the Office Action for a period of three months from December 3, 2002 up to and including February 3, 2003 is submitted concurrently herewith.

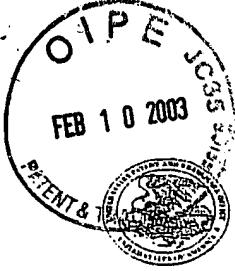
Respectfully submitted,

Date: February 3, 2003


Aaron T. Hokamura (Reg. No. 51,810)

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740 Bay Road
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(650) 569-5100

Enclosures



UNITED STATES PATENT AND TRADEMARK OFFICE

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/900,715 | 07/06/2001 | Keith D. Allen | R-775 | 3970 |

7590 10/03/2002

DELTAGEN, INC.
1003 Hamilton Avenue
Menlo Park, CA 94025

EXAMINER

WOITACH, JOSEPH T

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1632 | |

DATE MAILED: 10/03/2002

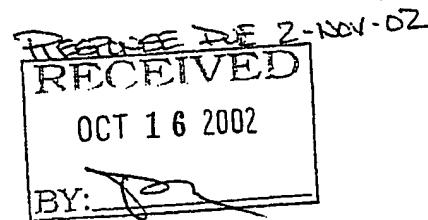
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Please find below and/or attached an Office communication concerning this application or proceeding.

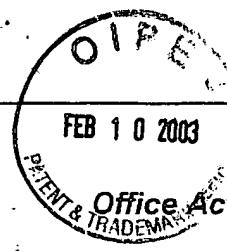
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DUE: NOV. 2, 2002

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|---|-------------------------------|---------------------------------|
| FEB 10 2003 Office Action Summary | Application No. 09/900,715 | Applicant(s) ALLEN, KEITH D. |
| | Examiner Joseph Woitach | Art Unit 1632 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
2a) This action is FINAL. 2b) This action is non-final.
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
5) Claim(s) ____ is/are allowed.
6) Claim(s) ____ is/are rejected.
7) Claim(s) ____ is/are objected to.
8) Claim(s) 1-25 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
11) The proposed drawing correction filed on ____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.
15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____.
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) Other: _____

Applicants Copy

Application/Control Number: 09/900,715

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DETAILED ACTION

This application filed July 6, 2001, claims benefit to provisional applications 60/216,104, filed July 6, 2000, and 60/223,386, filed August 7, 2000.

Applicants' amendment containing the sequence listing filed December 31, 2001, paper number 4, has been received and entered. The specification has been amended. Claims 1-25 are pending and currently under examination.

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12, 17-23, drawn to a targeting construct comprising a polynucleotide sequence homologous to the sequence encoding protein phosphatase 2C and a selectable marker and the transgenic animal generated with said construct, and method of producing said construct, classified in class 536, subclass 23.1; class 800, subclass 8; class 800, subclass 21; class 800, subclass 3..
- II. Claims 13-15 and 24, drawn to method of identifying an agent which modulates activity of protein phosphatase 2C in a cell comprising a disruption in a phosphatase 2C gene, classified in class 435, subclass 325.

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III. Claims 16 and 25, drawn to an agent which modulates the expression of protein phosphatase 2C, unclassifiable because the nature of the agent is not specifically set forth.

The inventions are distinct, each from the other because of the following reasons:

Inventions I -III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to different and separate products and methods which are materially different and capable of separate use. Specifically, the polynucleotide sequences and the animals can be used for *in vivo* assays to measure a physiological effect on an entire tissue or animal and the cells can be obtained separate from generating an animal and can be used for *in vitro* assays to study specific molecular signaling. The agent encompassed by group III is not clearly defined and could be identified by other methods and could be used in other assays. Each of Groups I-III are drawn to materially different inventions and would require a separate search and consideration.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach whose telephone number is (703)305-3732.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached at (703)305-4051.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist Pauline Farrier whose telephone number is (703)305-3550.

Papers related to this application may be submitted by facsimile transmission. Papers should be faxed via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center numbers are (703)308-4242 and (703)305-3014.

Joseph T. Woitach

Deborah Crouch

DEBORAH CROUCH
PRIMARY EXAMINER
GROUP 1600 / 630